

REMARKS

Claims 1-19, and 23-24 are canceled; claims 20-22 and 25 are withdrawn from consideration; and new claims 26-53 are added herein. Support for the amendments to the claims can be found, for example, in the original claims and in the original specification on page 2, lines 20-23, page 3, lines 17-19 and page 4, line 32 to page 8, line 28. Hence no issues of new matter are presented. Upon entry of the Amendment claims 20-22, and 25-53 will be all of the claims pending in the application.

I. Response to Objection to the Specification

A substitute specification is submitted herewith along with a marked up copy in compliance with 37 C.F.R. § 1.125 as required by the Examiner in the Office Action dated march 3, 2003. The substitute specification does not include any new matter. Applicants respectfully request acceptance and entry of the attached substitute specification.

Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

II. Response to Claim Rejections Under 35 U.S.C. § 112, 1st Paragraph

Claims 2-5, 8, 11-14 and 16-18 (and all dependent claims) are rejected under 35 U.S.C. § 112, 1st paragraph, as allegedly being non enabled by the specification for making and/or using the claimed invention. Specifically, the Examiner states that the process to generate the yeast strains required to practice the invention does not appear to be repeatable and it does not appear as if the materials are readily available to the public.

Applicants respectfully submit that the yeast strains required to practice the claimed invention have been deposited according to the Budapest Treaty. A Statement of Availability is submitted herewith indicating that the required yeast strains will be irrevocably and without restriction released to the public upon issuance of a patent in order to satisfy the deposit requirement.

Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Response to Claim Rejections Under 35 U.S.C. § 112, 2nd Paragraph

Claims 1-19, 23 and 24 are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite for failing to conform to current U.S. practice and containing grammatical and idiomatic errors.

The claims are amended herein for purposes of clarity, thereby obviating the rejection.

Claims 1-19, 23, and 24 are further rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite because the claims do not begin with an article such as “A” or “The”.

The claims are amended herein to correct this informality, thereby obviating the rejection.

Claims 1-15 are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite because of the use of the term “new”.

The claims are amended herein to correct this informality, thereby obviating the rejection.

Claims 1, 2 and 12 (and all dependent claims) are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite for the use of the term “i.e.” The Examiner considers the use of this term to be synonymous with “for example”.

Applicants respectfully submit that the term “i.e.” is a standard abbreviation which means “that is” or “that is to say” and not “for example”, which is commonly abbreviated as “e.g.” However, in order to facilitate and expedite examination and for the sake of clarity, Applicants have amended the claims and deleted this term, thereby obviating the rejection.

Claim 2 is rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite because of the use of the phrase “produced conventionally”. The Examiner states that the phrase is a relative term, which is not defined by the claim and for which the specification does not provide a standard for ascertaining the requisite degree such that one of ordinary skill in the art would be reasonably apprised of the scope of the claims.

Applicants respectfully traverse the rejection and submit that the fact that claim language includes relative terminology does not necessarily render a claim indefinite. The proper inquiry is to first determine whether the specification provides some standard for measuring degree and second whether one of ordinary skill in the art would understand what is claimed in light of the specification. In the present specification it is disclosed that a conventional process of baker’s yeast manufacture is a process described in Chapter 6, “Baker’s Yeast Production” of the handbook Yeast Technology, 2nd Ed., 1991, by Reed et al. *See* page 2, lines 20-23 of the original specification. A copy of the reference is attached for the Examiner’s convenience as Attachment A. The reference describes processes for producing baker’s yeast which were generally known in the art at the time of the present application. Further, the entire disclosure of the reference is incorporated into the present application as indicated on page 16, lines 7-11 of the original specification. Thus, when properly read in light of the specification, one of ordinary skill in the

art would be apprised of the meaning and scope of the claims. For purposes of clarity, the claims have been amended to cite to the reference, thereby obviating the rejection.

Claims 5, 8, 12 and 18 are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite for use of the term “similar”. The Examiner states that the term is a relative term, which is not defined in the claims and for which the specification does not provide a standard for ascertaining the requisite degree such that one of ordinary skill in the art would be reasonably apprised of the scope of the invention.

Applicants respectfully traverse the rejection and submit that the fact that claim language includes relative terminology does not necessarily render a claim indefinite. The proper inquiry is to first determine whether the specification provides some standard for measuring degree and second whether one of ordinary skill in the art would understand what is claimed in light of the specification. In this case, the claims recite “strains similar to the strains deposited according to the Budapest Convention with the “Collection Nationale de Cultures de Microorganismes”, Institut Pasteur, 28 rue de Docteur Roux, 75724 PARIS CEDEX 15, under the numbers I-2421 and I-2422. In the present specification it is disclosed that similar strains to the two strains CNCM I-2421 and CNCM I-2422 are defined as the strains sharing all the common properties to these two strains and/or as the strains able to be selected by the three series of systematical selection tests hereabove disclosed, i.e., the baker’s yeast strains which pass successfully the three systematical selection tests described herein. See page 10, line 33 to page 11, line 4 of the original specification. The three systematical selection tests are described in the specification beginning on page 4, line 32 to page 8, line 31. For the sake of clarity and conciseness, the first

selection test is now also referred to as test S1, the second selection test as test S2, and the third selection test as test S3. Thus, when properly read in light of the specification, one of ordinary skill in the art would readily understand the meaning and scope of the claims. The claims are amended herein to include the definition of the term “similar strains”, thereby obviating the rejection.

Claims 1 and 12 are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite because of the use of the term “good performances”. The Examiner states that the term is a relative term, which is not defined in the claim and for which the specification does not provide a standard for ascertaining the requisite degree such that one of ordinary skill in the art would reasonably be apprised of the scope of the claimed invention.

Applicants respectfully traverse the rejection and submit that one of ordinary skill in the art would readily be able to distinguish between yeast that have good general performance in not-delayed bread-making processes and those that do not. It is part of the baker’s daily practice to detect and reject yeasts that do not perform sufficiently well in the bread-making process used (in this case not-delayed bread-making) resulting in particular in insufficiently raised loaves. Thus evaluation of the general performance of yeast in raising dough is an essential part of bread-making and is part of the general knowledge and practice of one skilled in the baker’s art.

Evaluation of general good performance of a yeast in not delayed bread-making can, for example be evaluated using the fermentometer tests A₁, A₅, A₆ carried out with the fermentometer of Burrows and Harrison as described on page 2 of the specification. Thus, one of ordinary skill in the art would readily understand the meaning and scope of the claims based

upon the disclosure in the present specification and the knowledge and skill generally available within the art.

Claims 1 and 12 are further rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite in view of the terms “bad taste” and “off-flavors”, which are said to be relative terms that are not defined in the claims and for which the specification does not provide a standard for ascertaining the requisite degree such that one of ordinary skill in the art would reasonably be apprised of the scope of the invention.

Applicants respectfully traverse the rejection and submit that the fact that claim language includes relative terminology does not necessarily render a claim indefinite. The proper inquiry is to first determine whether the specification provides some standard for measuring degree and second whether one of ordinary skill in the art would understand what is claimed in light of the specification. In this case, a test is disclosed in the present specification, which describes in detail how one of ordinary skill in the art can determine and select baker’s yeast that do not produce bad taste or off-flavors in the presence of cinnamon based upon a comparison of odors, which is confirmed by analysis of the decomposition rate of cinnamic acid. See page 5, line 9 to page 6, line 25. Thus, when properly read in light of the specification, one of ordinary skill in the art would readily be able to ascertain the meaning and scope of the claims.

Claims 9-11 are rejected under 35 U.S.C. § 112, 2nd paragraph as allegedly being indefinite for reciting a broad range limitation together with a narrow range limitation that falls within the broad range in the same claim.

The claims are amended herein thereby obviating the rejection.

Claims 8 and 11 are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite for containing improper Markush language.

The claims are amended herein, thereby obviating the rejection.

Claim 2 is rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly indefinite because of the recitation of the trademark “CHOPIN®”, which identifies the source of goods and not the goods themselves.

The claim is amended herein thereby obviating the rejection.

In view of the above, Applicants respectfully request withdrawal of the rejections.

IV. Response to Claim Rejections Under 35 U.S.C. § 102

Claims 1-3, 5, 13, 16 and 18 (and all dependent claims) are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,741,695. The Examiner states that the ‘695 patent describes new baker’s yeast strains generated by a standard method described in U.S. Patent No. 4,396,632 and that “by Applicants’ own admission, strain L17, also known as strain I-2421 was originally disclosed in the ‘695 patent (emphasis added). It is the Examiner’s position that the properties of the strain as presently claimed were inherent to the strain and therefore the strain is not patentable and that any claims relating to the production of strain CNCM I-2421 using the method described in the ‘695 patent is anticipated.

Applicants respectfully traverse the rejection and submit that the claimed invention is not anticipated by US ‘695 within the meaning of 35 U.S.C. § 102(b). The Examiner appears to rely on the disclosure in the original specification on page 4, 1st paragraph (not page 17 of the specification as indicated in the Office Action), which states:

Strain now called L17 in reason of its possible industrial use and deposited under the number CNCM I-2421 had been **cited** in a different context in US Patent No. 5,741,695, but the said strain had been considered at the time as presenting no interest as a baker's yeast strain due to its too high invertase content.

Applicants' have indicated in the present specification that the claimed baker's yeast strain I-2421 was cited in the '695 patent, but not disclosed. The distinction between cited and disclosed is significant in that in order for the claims of the present invention to be anticipated within the meaning of 35 U.S.C. § 102(b) the claimed invention must be disclosed in the '695 patent, such that one of ordinary skill in the art could make and or use the claimed invention. In this case, the cited strain (strain L17) was not deposited prior to March 24, 2000; was kept private and confidential, without being commercially used; and was not accessible to third parties as indicated in the original specification on page 4, lines 4-9. Thus, since the biological material was not known, or made readily available to the public, citation, or mention of the strain, absent a deposit of the required biological material for making and/or using the present invention is not an enabling disclosure and the presently claimed invention therefore, is not anticipated.

According to the information provided in the '695 patent, strain 3597 (i.e., strain L17 or I-2421) was obtained by crossing haploid strain H037 (filed with the CNCM under number I-1076) with a series of haploids having a number of properties, such as invertase activity above 20 units, but which haploids are not further identified in the '695 patent, followed by a selection based on a number of tests (in particular tests A, A10 and A9) from the numerous haploids

obtained. Strain 3597, thus obtained, was further transformed and the resulting transformed strain was deposited with the CNCM and with the National Collection of Yeast Culture (NCYC).

It will be immediately apparent to a person of ordinary skill in the art that, in the absence of an identified deposit under the Budapest Treaty, the description of a method for obtaining a specific strain by means of hybridization between an identified and unidentified parent strain followed by selection, in no way amounts to an enabling disclosure of a specific strain thereby obtained, in view of a number of unknown factors.

Regarding the teachings of the '695 patent, it is also highly relevant to note that the '695 patent in no way addresses the aspects of the resistance to stress caused to the yeast by freezing (in sweet doughs) nor of the absence of the production of off-flavors in the presence of cinnamon. Further the '695 patent does not disclose any tests for the determination of the presence or absence of such properties in a given baker's yeast, whereas the presence of these properties and their determination are essential aspects of the baker's yeast according to the present invention.

It is therefore respectfully submitted that, although the '695 patent refers to the now claimed strain L17 or I-2421, the '695 patent does not provide an enabling disclosure of said specific strain. Therefore, the presently claimed invention is not anticipated by the '695 patent.

Accordingly, Applicants respectfully request withdrawal of the rejection.

V. Response to Claim Rejections Under 35 U.S.C. § 103

Claims 7, 8, 19 and 24 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over US '695 in view of US '250.

The Examiner asserts that the '695 patent teaches the use of the claimed I-2421 yeast strain (based upon the disclosure in the present specification discussed above) to generate new baker's yeast strains by a standard process.

The Examiner recognizes that the '695 patent does not specifically teach the final cultivation step involving a discontinuous flow of molasses recited in the claims.

To remedy this deficiency, the Examiner relies on the '250 patent for the teaching of the use of a discontinuous flow of molasses during the final cultivation cycle in the preparation of the disclosed baker's yeast strain for the purpose of generating yeast that perform well in sweetened dough independent of the sugar content and to lower the invertase content of the yeast.

It is the Examiner's position that it would have been obvious to one of ordinary skill in the art to combine the teaching the '695 patent and the '250 patent to use the claimed I-2421 strain to generate baker's yeast using the process of the '250 patent wherein a discontinuous flow of molasses is used during the final cultivation cycle to obtain a baker's yeast strain for use with sweetened dough whereby the invertase content is lowered and the osmotolerance is decreased.

Applicants respectfully traverse the rejection and submit that the Examiner has not made a *prima facie* showing of obviousness. As discussed above, the '695 patent does not provide an enabling disclosure of the presently claimed baker's yeast. Claims 7, 8 and 24 ultimately depend on claim 1 and are distinguished over the '695 patent for at least the same reason. The '250 patent does not remedy the deficiency of the '695 patent as discussed above in that it does not teach or suggest the presently claimed baker's yeast or the process for making the claimed

baker's yeast. Therefore one of ordinary skill in the art would not have been motivated to combine the disclosures of the '695 patent and the '250 patent with a reasonable expectation of achieving the presently claimed inventions.

With respect to claim 19, Applicants submit that claim 19 depends from claim 16, which is not included in the rejection. Claim 19 is distinguished over the cited references for at least the same reason as claim 16. Further, the '695 patent and the '250 patent, taken alone or in combination, do not teach or suggest the recited I-2421 yeast strain for the reasons set forth above.

Accordingly, Applicants respectfully request withdrawal of the rejection.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application Serial No. 09/716,639

Attorney Docket No. Q68857

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Respectfully submitted,

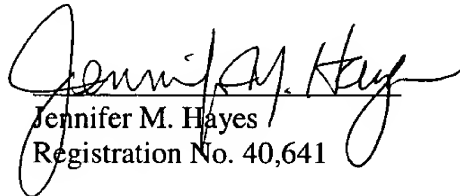
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